

REMARKS

Claims 1-5, 7-12, 14-21, and 23-25 are pending in the application.

The Applicants respectfully request the Examiner to reconsider earlier rejections in light of the following remarks. No new issues are raised nor is further search required as a result of the changes made herein. Entry of the Amendment is respectfully requested.

Interview

The Applicants thank the Examiner for the interview conducted on April 20, 2004. During the interview the Applicants discussed the cited prior art in relation to the pending claims.

To help further clarify the pending claims over the cited prior art, the Applicants suggested amendments to the claims. The suggested amendments to the claims were agreed to by Examiner to overcome the rejection over the cited prior art.

35 USC 112 First Paragraph Rejection of Claims 1-4

The Office Action rejected claims 1-4 as allegedly failing to comply with the written description requirement under 35 USC 112. In particular, the Office Action alleges that the claimed "optical character recognizer adapted to recognize and textually convert header information" and a "modem adapted to automatically transmit said image with said header information based on said textually converted header information" is not supported by the originally filed specification.

During the interview conducted on April 20, 2004 the Examiner agreed to withdraw the 35 USC 112, first paragraph rejection of claims 1-4. In particular, the Applicants directed the Examiner to, e.g., page 6, lines 20-30 and page 8, lines 29-31.

It is respectfully submitted that claims 1-4 are described in the specification in full conformance with 35 USC 112. It is respectfully requested that the rejection be formally withdrawn.

35 USC 112 First Paragraph Rejection of Claims 1-4

The Office Action rejected claims 1-4 as allegedly failing to comply with the requirement to disclose the best mode of invention. In particular, the Examiner points to the specification, pages 10 and 12, that allegedly describes a header to be a designation of a party to whom a document is sent.

During the interview conducted on April 20, 2004 the Examiner agreed to withdraw the 35 USC 112 first paragraph rejection of claims 1-4. In particular, the Applicants directed the Examiner to, e.g., page 6, lines 24-30. The specification describes a header to be a designation of a sender's information. The sender's information disclosed as being, e.g., the sender's telephone number and/or name.

It is respectfully submitted that the subject matter of claims 1-4 is described in the specification in full conformance with 35 USC 112. It is respectfully requested that the rejection be formally withdrawn.

35 USC 132 Rejection

The Office Action rejected the amendment filed January 21, 2004 under 35 USC 132 as allegedly introducing new matter into the disclosure. In particular, the Office Action alleged that an optical reader adapted to convert header information and transmission of textually converted header information is not supported by the original disclosure.

During the interview conducted on April 20, 2004 the Examiner agreed to withdraw the 35 USC 132 rejection. In particular, the Applicants directed the Examiner to, e.g., page 6, lines 24-30 and page 9, lines 25-30.

It is respectfully submitted that the recited language is supported by the originally filed specification. It is respectfully requested that the rejection be formally withdrawn.

Claims 1, 2, 5-9, 11-16 and 18-23 over Baran

In the Office Action, claims 1, 2, 5-9, 11-16 and 18-23 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Baran et al., U.S. Patent No. 4,893,333 ("Baran"). The Applicants respectfully traverse the rejection.

Claims 1, 2, 5-9, 11-16 and 18-23 recite textually converted data that is sender information in a header.

Baran appears to disclose facsimile transceivers to interactively select and retrieve facsimile pages from a shared facsimile database FAX serve system (Abstract). A user fills in information on a selector sheet, such as an advertisement, and transmits at least bar code portions of the advertisement via a FAX transceiver (Baran, col. 7, lines 5-20). Hand printed characters on the selector sheet are read by a receiving FAX server and used to send information back to a user (Baran, col. 7, lines 21-39). A user can fill out personal information on the request for information from the FAX server (Baran, Fig. 2).

Although Baran discloses textually converted data being personal information of a sender, the textually converted data is **NOT** placed in a header, as recited by claims 1, 2, 5-9, 11-16 and 18-23.

The Examiner points to Baran Fig. 2a and 2g as disclosing scanned sender information in a header portion of an outgoing facsimile (Office Action, page 5). However, neither Fig. 2a nor Fig. 2g, nor any other of Baran's Figs. show any header. A header is a portion of a document at the very top of a page conveying information about a document, e.g., for FAXs the sender name and telephone number is typically included in a header of a document. Any other interpretation would be inconsistent with the interpretation that those skilled in the art would reach, and hence would be unreasonable. Cf. In re Cortright, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Finally, the broadest reasonable interpretation cannot be inconsistent with the specification, which illustrates the claimed header (see, e.g., Figure 2). Hence, "claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest

reasonable interpretation.” MPEP ' 2111.01 at 2100-37 (Rev. 1, Feb. 2000) (quoting In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983)(emphasis in original)).

Claims 1, 2, 5-9, 11-16 and 18-23 recite textually converted data that is transmitted in place of a default header.

Baran discloses textually converted data that is used to retrieve facsimile pages from a shared facsimile database FAX serve system. Baran fails to disclose or suggest using a default header, much less textually converted data that is transmitted in place of a default header, as recited by claims 1, 2, 5-9, 11-16 and 18-23.

A benefit of a header based on and identified textually converted information and data is, e.g., the ability to share a fax machine in an office. In an office that shares a fax machine, a plurality of users may want to have a header for their fax that is customized. By having a header based on textually converted information and data, a page within a fax can be textually converted and used to create a custom header for each individual user within an office in place of a default header.

Accordingly, for at least all the above reasons, claims 1, 2, 5-9, 11-16 and 18-23 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claim 3 over Baran in view of Nakamura

In the Office Action, claim 3 was rejected under 35 U.S.C. §103(a) as allegedly being obvious over Baran in view of Nakamura et al., U.S. Patent No. 5,781,310 (“Nakamura”). The Applicants respectfully traverse the rejection.

Claim 3 is dependent on claim 1, and is allowable for at least the same reasons as claim 1.

Claim 3 recites textually converted data that is sender information in a header and textually converted data that is transmitted in place of a default header.

As discussed above, Baran fails to disclose or suggest textually converted data that is sender information in a header and textually converted data that is transmitted in place of a default header, as recited by claim 3.

The Office Action relies on Nakamura to alleged make up for the deficiencies in Baran to arrive at the claimed invention. The Applicants respectfully disagree.

Nakamura appears to disclose a copying system in which an image inputting unit and an image outputting unit are connected via a conventional data transmission path (Abstract). A color image sensor device scans a reference white plate first, and background data obtained by scanning the reference white plate (Nakamura, col. 5, lines 29-31). Data scanned thereafter is corrected in accordance with the background data (Nakamura, col. 5, lines 34-36).

Nakamura discloses scanning a reference white plate to calibrate a scanner, having nothing to do with a transmitting textually converted data, much less disclose or suggest textually converted data that is sender information in a header and textually converted data that is transmitted in place of a default header, as recited by claim 3.

Neither Baran nor Nakamura, either alone or in combination, disclose, teach or suggest textually converted data that is sender information in a header and textually converted data that is transmitted in place of a default header, as recited by claim 3.

Accordingly, for at least all the above reasons, claim 3 is patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claim 4, 10 and 17 over Baran in view of Nakamura and Eguchi

In the Office Action, claim 4 was rejected under 35 U.S.C. §103(a) as allegedly being obvious over Baran in view of Nakamura, and further in view of Eguchi, U.S. Patent No. 6,219,150 ("Eguchi"), and claims 10 and 17 rejected under 35 U.S.C. §103(a) as allegedly being obvious over Baran in view of Eguchi. The Applicants respectfully traverse the rejection.

Claim 4, 10 and 17 are dependent on claims 1, 5 and 12 respectively, and are allowable for at least the same reasons as claims 1, 5 and 12.

Claims 4, 10 and 17 recite textually converted data that is sender information in a header and textually converted data that is transmitted in place of a default header.

As discussed above, neither Baran nor Nakamura, either alone or in combination, disclose, teach or suggest textually converted data that is sender information in a header and textually converted data that is transmitted in place of a default header, as recited by claims 4, 10 and 17.

The Office Action relies on Eguchi to alleged make up for the deficiencies in Baran and Nagamura to arrive at the claimed invention. The Applicants respectfully disagree.

Eguchi appears to disclose a communication terminal device having an electronic mail function that is capable of reproducing a single original image even if it receives a plurality of electronic mails (Abstract). A main control unit refers to header information of each of received electronic mails to determine whether or not each of the electronic mails corresponds to an original image (Eguchi, col. 5, lines 7-13).

Eguchi discloses use of headers associated with electronic mail messages. However, the headers are **NOT** disclosed or suggested as based on and identified by textually converted information and data and are **NOT** transmitted in place of a default header, as recited by claims 4, 10 and 17.

Neither Baran, Nakamura nor Eguchi, either alone or in combination, disclose, teach or suggest textually converted data that is sender

information in a header and textually converted data that is transmitted in place of a default header, as recited by claims 4, 10 and 17.

Accordingly, for at least all the above reasons, claims 4, 10 and 17 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,
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A handwritten signature in black ink, appearing to read "Will Bollman", written over a horizontal line.

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